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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,625	01/22/2004	Yaacov Almog	600204528-XUDS-A	7724
22879 7590 11/16/2009 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528				
EXAMINER FERGUSON, LAWRENCE D				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 11/16/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/763,625

Applicant(s)

ALMOG ET AL.

Examiner

Lawrence D. Ferguson

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38, 40-43, 45-48 and 51-58 is/are pending in the application.
- 4a) Of the above claim(s) 48 and 51-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38, 40-43, 45-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed July 16, 2009.

Claims 38, 43 and 48 were amended rendering claims 38, 40-43, 45-48 and 51-58 pending, with claims 48 and 51-58 withdrawn as a non-elected invention.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections – 35 USC § 102(b)

3. Claims 38, 40, 42-43, 45 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Bodager et al. (U.S. 5,565,301).

Bodager discloses a coated paper substrate comprising a carrier support (1), which is a paper substrate (column 4, lines 55-67 and Figure 3) along with a carrier surface layer (2) that is a cushion layer, which is preferably ethylene acrylic acid copolymer (column 5, lines 15-16, 49-62 and Figure 3). Bodager further discloses an anchor layer between the carrier cushion layer and carrier support layer that comprises

polyamides (column 6, lines 10-24). The anchor layer is a Macromelt (column 20, lines 59-60) which Applicant defines as an amine terminated polyamide in paragraph 0005 in the instant specification. Bodager discloses colored images (print) are formed on the article (column 1, line 6, column 2, lines 39-40, column 5, lines 38-45). The anchor layer remains adhesively bonded to the layers on both sides (has a high affinity for the substrate and overlayer) (column 6, lines 10-15). In claims 38 and 43, the phrase, "toner image can be fused and fixed" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claims 38 and 43, the phrase, "for printing a toner image thereon" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Because Bodager discloses a coated paper having the same layers, with the same materials it is inherent for the coated paper to be capable of being configured for printing a toner image thereon, as in claims 38 and 42-43 and 47.

Concerning claims 40 and 45, although the cushion layer can include additives as in column 5, line 66 through column 6, line 7, additives are not required in the layer; therefore it is reasonable to conclude that the layer is free of particulate matter.

Claim Rejections – 35 USC § 103(a)

4. Claims 38, 40-41, 43 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (U.S. 5,250,990) in view of Graham et al (U.S. 4,602,058).

Fujimura discloses a coated paper substrate comprising a paper substrate (column 8, lines 24-26) coated with a photosensitive layer, where the photosensitive layer comprises a charge generation layer and charge transportation layer (column 7, line 67 through column 8, line 1) where the charge generation layer and charge transportation layers comprise styrene butadiene copolymer (column 7, lines 14-26, 56-57). Fujimura further discloses a polyamide primer layer can be provided between the substrate layer and photosensitive layer (column 8, lines 27-34) which can be printed with a toner image (column 1, lines 13-23). In claim 38, the phrase, "toner image can be fused and fixed" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claim 38, the phrase, "for printing a toner image thereon" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Fujimura does not disclose the polyamide layer is an amine terminated polyamide. Graham teaches a coated paper, where two layers are bonded together

using an amine-terminated polyamide interlayer (column 11, lines 46-53, column 12, lines 60-68 and column 13, lines 1-4). Fujimura and Graham are combinable because they are related to a similar technical field, which is coated papers. It would have been obvious to one of ordinary skill in the art to substitute the amine terminated polyamide coating layer of Graham for the polyamide primer (coating) layer of Fujimura because Graham teaches polyamide layers are commercially made using amine-terminated polyamides (column 5, lines 33-38 and column 11, lines 46-53 of Graham), as in claim 38 and 41.

Concerning claims 40 and 45, the photosensitive layer appears to be free of particulate matter.

Concerning claims 43 and 46, the article is image forming and can be printed (column 1, lines 13-15). Because Fujimura and Graham disclose a printed article having a paper substrate coated with an underlayer and overlayer having similar materials, it is expected for the underlayer to have a high affinity for the substrate, for the overlayer to have a high affinity for toner and for the underlayer and overlayer to have high affinity for each other, absent any evidence to the contrary. In claim 43, the phrase, "toner image can be fused and fixed" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. Additionally, in claim 43, the phrase, "for printing a toner image thereon" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Response to Arguments

5. Applicant's arguments of the rejection made under 35 U.S.C. 102(b) as being anticipated by Bodager et al. (U.S. 5,565,301) have been considered but are unpersuasive. Applicant argues Bodager does not disclose or suggest a paper substrate, because the reference discloses a paper substrate that has been treated to be water resistant. Examiner respectfully disagrees because Bodager discloses the carrier support can be a paper sheet or synthetic paper that has been treated to be water resistant. The reference does not disclose that the paper sheet has been treated to be water resistant, but that the synthetic paper has been treated to be water resistant. Therefore, Bodager meets the claim limitation of a paper substrate.

Applicant's arguments of the rejection made under 35 U.S.C. 103(a) as being unpatentable over Fujimura et al. (U.S. 5,250,990) in view of Graham et al (U.S. 4,602,058) have been considered but are unpersuasive. Applicant argues that an electroconductive substrate is not the same as a paper substrate. Fujimura discloses the paper substrate is impregnated with electroconductive particles (column 8, lines 24-26). Because Fujimura discloses a paper substrate, this disclosure meets the claim

limitation of a paper substrate, as the instant claims do not exclude the paper substrate from being impregnated with additional materials.

Applicant further argues, as admitted in the Office Action, Fujimura does not disclose an underlayer coating including amine terminated polyamide. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Graham teaches a coated paper, where two layers are bonded together using an amine-terminated polyamide interlayer (column 11, lines 46-53, column 12, lines 60-68 and column 13, lines 1-4). Applicant argues the underlayer coating as taught in Graham contains an amine terminated polyamide and ethylene copolymers containing carboxyl groups that forms a blend, where the instant claims contain an amine terminated polyamide and not a polyamide blend. Although Applicant has amended claims 1 and 43 to having an underlayer or undercoating that contains amine terminated polyamide, the preamble of both claims discloses a coated paper substrate or paper-based print media that comprises a paper substrate and subsequent coatings. Because the articles comprise the substrates and coatings, the additional material of the polyamide layer is not excluded from the disclosure of the instantly claimed invention. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or

method steps. See, e.g., *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003).

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample, can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Lawrence Ferguson/
Patent Examiner, Art Unit 1794

/David R. Sample/
Supervisory Patent Examiner, Art Unit 1794